

## REMARKS

The claims are claims 1, 10, 12, 29, 34, 46, 49, 52 and 55 to 58.

Claims 34 and 49 are amended to address claim objections and rejections under 35 U.S.C. 112. New claims 55 to 58 are added reciting subject matter disclosed in the application at page 12, lines 1 to 4.

The FINAL REJECTION objected to claim 34 on the basis of informality. Claim 34 has been amended as suggested by the Examiner and should now be proper.

Claim 49 was rejected under 35 U.S.C. 112 as indefinite in claiming a single means.

Claim 49 has been amended to include recitation of "means for presenting customized content" from prior base claim 10. The previous amendment intended to present claim 49 in independent form but failed to include this limitation of prior base claim 10. As amended claim 49 no longer recites a single means. Accordingly, claim 49 is proper under 35 U.S.C. 112.

Claims 1, 10, 12, 29, 34, 46, 49 and 52 were rejected under 35 U.S.C. 103(a) as made obvious by the combination of Merjanian U.S. Patent No. 5,920,642 and Darbee et al U.S. Patent No. 6,130,726.

Claims 1, 10, 12 and 29 recite subject matter not made obvious by the combination of Merjanian and Darbee et al. Claims 1, 10, 12 and 29 recite "some control keys disposed in a thumb actuated cross configuration" and "the fingerprint sensor is integrated within a middle portion of the thumb operated cross configuration." The FINAL REJECTION admits that Merjanian does not disclose this limitation but cites Darbee et al as teaching the recited thumb actuated cross configuration. The FINAL REJECTION fails to provide any motivation for incorporating the fingerprint sensor of

Merjanian into the OK key of Darbee et al. In contrast, this application states at page 11, lines 13 to 17:

"The illustrated embodiment has an arrangement in which the volume up/down keys 43 and channel up/down keys 45 are positioned in a thumb operated cross 40, with the finger print apparatus 26 located in the middle of the cross 40. This arrangement allows non-participatory identification of the user by analyzing the user's thumbprint when the user changes channels or the volume."

This application also provides clear teaching of the advantage of such "non-participatory identification of the user." There is no teaching in either reference that such a combination is feasible or advantageous. Note that Merjanian illustrates in Figure 7 platen 30 exposed to the user's digit and a set of keys 212H, 212I, 212J and 212K disposed in a cross configuration omitting the claimed middle portion. Darbee et al teaches a keyboard 15 including a cross configuration of keys with a middle OK key. Darbee et al also discloses at column 4, lines 5 to 11 a fingerprint recognition device. Accordingly, both references teach the essential parts of these claims. However, neither reference includes any teaching that a fingerprint sensor can be used with a middle portion of a set of thumb actuated control keys in a cross configuration. The Applicants respectfully submit that the existence of the separate parts of the claimed invention in the prior art without the claimed combination is evidence of unobviousness. Accordingly, claims 1, 10, 12 and 29 are allowable over the combination of Merjanian and Darbee et al.

Claims 34, 46, 49 and 52 recite subject matter not made obvious by the combination of Merjanian and Darbee et al. Claims 34, 46, 49 and 52 recite "said control keys include an activation key operable to activate the remote control device, and said

fingerprint sensor is embedded in the activation key." The FINAL REJECTION states at page 8, lines 17 to 20:

"(see at least FIG. 7; it is noted that operating any of the buttons shown inherently activates the remote controller which does not need to be turned on per se with a button which is reserved only for turning on/off the remote controller)."

This inherency of Merjanian fails to make obvious the recited limitation. While the FINAL REJECTION states that the remote control of Merjanian does not need to be turned on, these claims recite "an activation key operable to activate the remote control device." Thus Merjanian not needing to be turned on does not make obvious the recited activation key. Likewise, while Darbee et al discloses power supply 30, supervisory circuit 31 and batteries 32, it fails to disclose that activation of any key is necessary to active the remote control unit. The FINAL REJECTION states at page 9, lines 19 to 24 and at page 10, lines 19 to 23:

"However, in an analogous art, Darbee teaches a remote control device with an OK, or PWR control key (see at least FIG. 1) for the purpose of selectively downloading advertising and programming data to be stored on the remote control depending upon identification of the user of the remote control or based upon some assessment of the viewing habits or preferences of the user (3:31-39)."

The FINAL REJECTION makes similar arguments regarding claim 52 at page 11, line 22 to page 12, line 3. Darbee et al includes no teaching regarding the operation of the OK key. Accordingly, this cannot make obvious the specific limitation recited in claims 34, 46, 49 and 52. Further, Darbee et al includes no teaching regarding the operation of the PWR key. The Applicants respectfully submit that one skilled in the art would believe this PWR key operates to activate the controlled device rather than the remote control device as recited in claims 34, 46, 49 and 52. Thus the

cited teachings of Darbee et al teach activation of a different apparatus than recited in these claims. Merjanian and Darbee et al fail to teach that operation of a control key actuates the remote control device as required by the limitations of claims 334, 46, 49 and 51. In contrast, this application states at page 11, line to page 12, line 1:

"In another preferred embodiment, the finger print apparatus 26 is incorporated on the remote control device 41 as an 'activate remote' key that must be pressed in order for the remote to start functioning. In this embodiment, the finger print can be read when the remote control is activated."

Embedding the fingerprint sensor in such an activate remote key ensures capture of the user's fingerprint before any controlled operation. The combination of teachings cited in the OFFICE ACTION fails to make such a requirement. Accordingly, claims 34, 46, 49 and 52 are allowable over the combination of Merjanian and Darbee et al.

New claims 55 to 58 recite subject matter not made obvious by the combination of Merjanian and Darbee et al. Neither Merjanian nor Darbee et al disclose the claimed sleep mode forgetting fingerprint data or that return from sleep mode re-acquires fingerprint data.

The Applicants respectfully submit that all the present claims are allowable for the reasons set forth above. Therefore early reconsideration and advance to issue are respectfully requested.

If the Examiner has any questions or other correspondence regarding this application, Applicants request that the Examiner contact Applicants' attorney at the below listed telephone number and address to facilitate prosecution.

Texas Instruments Incorporated  
P.O. Box 655474 M/S 3999  
Dallas, Texas 75265  
(972) 917-5290  
Fax: (972) 917-4418

Respectfully submitted,

/Robert D. Marshall, Jr./  
Robert D. Marshall, Jr.  
Reg. No. 28,527